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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,609	07/28/2006	Satoshi Kondo	128875	9512
25944 7590 10/07/2010 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
RAHIM, MONJUR				
ART UNIT		PAPER NUMBER		
2492				
NOTIFICATION DATE		DELIVERY MODE		
10/07/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarnstrong@oliff.com

### Office Action Summary

**Application No.**

10/587,609

**Applicant(s)**

KONDO ET AL.

**Examiner**

MONJOUR RAHIM

**Art Unit**

2434

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7, 15 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 15 and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 4/20/2010

### DETAILED ACTION

1. This action is in response to the amendment and argument filed on **16 July 2010**.
2. **Claims 7, 15, 19-22 remain rejected.**

### Responses to the Argument

3. The applicant's arguments during the **15 July 2010** interview are moot in view of new ground of rejection rendered.

### Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 15, 22** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In regard to **Claim 15** recites "a computer-readable storage medium, but computer-readable medium is not defined in the specification of the application. Pending claims are interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989). The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals per se in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent (See MPEP 2111.01). When the broadest reasonable interpretation of a claim covers a signal per se, the claim must be rejected under 35 U.S.C. §101 as covering non-statutory subject matter. See *In re Nuijten*, 500 F.3d 1346, 1356-57 (Fed. Cir. 2007) (transitory embodiments are not directed to statutory subject matter) and Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101, Aug. 24, 2009; p. 2.

A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory

embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. Cf. *Animals – Patentability*, 1077 Off. Gaz. Pat. Office 24 (April 21, 1987).

In regard to **Claim 22** is rejected under 35 U.S.C. 101 because while the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process.

The method including “step of receiving”, “step of executing”, “step of cancelling” and “step of determining” elements are **not tied to a machine and could have done by a human being**, hence non-statutory subject matter.

#### **Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 7, 15, 19-21** are rejected **35 U.S.C §102(e)** as being anticipated by over Elgressy et al (US Publication No. 20030056117), hereinafter Elgressy.

In regard to **claim 7**, Elgressy discloses:

- **a storing unit that stores information on whether a function of a program provided via a network is permitted to be used** (Elgressy, ¶22), wherein gateways stores the security policy (permission information).

- a receiving unit (Elgressy, ¶22), wherein gateway also is the receiving unit.
- a first receipt control unit that receives, using the receiving unit, before receiving the program via the network, function information indicating the function used in the program (Elgressy, ¶22, ¶24), wherein gateway ( the receiver) with the analyzing function (receipt control unit) receives the object header (receipt).
- a determining unit that determines whether to receive the program, by comparing the function information received by the first receipt control unit and information stored by the storing unit (Elgressy, 24-¶28), wherein determination is done by comparing stored policy.
- a second receipt control unit that receives, using the receiving unit, the program via the network if the determining unit determines to receive the program, and that cancels receipt of the program via the network if the determining unit determines not to receive the program; and (Elgressy, ¶28), wherein determination done to allow or prevent downloading programs/application.
- an executing unit that executes the program received by the second receipt control unit (Elgressy, ¶27), wherein initiation of downloading is the executing program.

In regard to **claim 15**, Elgressy discloses:

- a first step of receiving, before receiving a program, function information indicating a function used in the program (Elgressy, ¶22, ¶24), wherein the object header is the information of the object/program.
- a second step of determining, by comparing the function information received in the first step and information on whether the function of a the program is permitted to be used, which is pre-registered in memory, whether to receive the program associated with the function information (Elgressy, ¶33), wherein determination is done by comparing header of the Executable with stored value in the look up table, inherently these values are pre-registered to determine which objects can be allowed or rejected.
- a third step of receiving a program if it is determined in the second step to receive the program (Elgressy, ¶48-¶52).

- **a fourth step of executing a program received in the third step** (Elgressy, ¶27), wherein initiating download is the execution of a program.

- **a fifth step of cancelling reception of the program via the network if it is determined in the second step not to receive the program** (Elgressy, ¶28), wherein determination done to allow or prevent downloading programs/application.

In regard to **claim 19**, claim 7 is incorporated and Elgressy discloses:

- **wherein the determining unit further compares the function information received by the first receipt control unit and the information stored by the storing unit, and permits execution of the program when the function contained in the function information is permitted to be used** (Elgressy, ¶28).

In regard to **claim 20**, claim 7 is incorporated and Elgressy discloses:

- **the storing unit stores information on whether the function of the program is permitted to be used** (Elgressy, ¶22).

- **the function information is information on the function contained in the program to be received** (Elgressy, ¶33), wherein header contains the information about the executable objects.

In regard to **claim 21**, claim 7 is incorporated and Elgressy discloses:

- **the storing unit stores information on whether a resource of a received program is permitted to be accessed** (Elgressy, ¶24).

- **And the function information is information on a resource accessed in accordance with a program to be received** (Elgressy, ¶33), wherein header contains the information about the executable objects.

In regard to **claim 22**, Elgressy discloses:

- **a first step of receiving, before receiving a program via a network, function information indicating a function used in the program** (Elgressy, ¶22, ¶24), wherein the object header is the information of the object/program.

- a second step of determining, by comparing function information received in the first step and information on whether the function of the program is permitted to be used, which is pre-registered in memory, whether to receive the program associated with the function information (Elgressy, ¶33), wherein determination is done by comparing header of the Executable with stored value in the look up table, inherently these values are pre-registered to determine which objects can be allowed or rejected.

- a third step of receiving the program via the network if it is determined in the second step to receive the program (Elgressy, ¶48-¶52).

- a fourth step of executing the program received in the third step (Elgressy, ¶27), wherein initiating download is the execution of a program.

- a fifth step of canceling reception of the program via the network if it is determined in the second step not to receive the program (Elgressy, ¶28), wherein determination is done to allow or prevent downloading programs/application.

### Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form "PTO-892 Notice of Reference Cited").

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monjour Rahim whose telephone number is (571)270-3890. The examiner can normally be reached on 5:30 AM -3:30 PM (Mo-Th).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571)272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair.direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (in USA or CANADA) or 571-272-1000.

/Monjour Rahim/  
Patent Examiner  
Art Unit: 2434  
Date: 9/30/2010

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434